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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,385	07/23/2003	Ajaykumar R. Idnani	CE09424i	9506

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EXAMINER
YU, XIANG

ART UNIT	PAPER NUMBER
2445	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

	Application No.	Applicant(s)
Office Action Summary	10/625,385	IDNANI ET AL.
	Examiner	Art Unit	
	Xiang Yu	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 July 2003_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _23 July 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _09 April 2004_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This is a non-final Office Action in response to the present US application

number 10/625,385 filed on July 23rd, 2003 and IDS filed on April 09th, 2004.   Claims 1-

15 are pending and have been examined.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. In particular, according to the disclosure, the components

are logical and not physical. Thus, the interface and the various components are all

software modules per se.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claims 1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Publication No. US 2002/0042277 A1 to *Smith, Steven W.* ("*Smith*") in view

of U.S. Patent Publication No. US 2002/0026527 to *Das et al.* ("*Das*").

As to **claim 1**, *Smith* does not fully discloses **a method for maintaining SIP contact addresses using event subscription:**

receiving, by a SIP proxy user agent (UA), a non-SIP registration request from a remote unit. In particular, *Smith* discloses the concept within one of the various embodiments wherein a client (2G subscriber) registering with a SIP proxy (e.g. *Smith:* paragraphs [0039] and [0044]).

In addition, *Das* also further discloses the concept of a mobile client node can request to register with a dynamic tunneling agent (DTA) in a foreign (or remote) network (which are equivalent to SIP proxy user agents in a home network) (e.g. *Das:* paragraph [0060])**;**

sending, in response to the registration request, a combined registration and event subscription message for the remote unit to a SIP registrar. In particular, *Smith* discloses the concept within one of the various embodiments wherein the 2G client subscriber in addition to registering is also subscribing to receive information from the 3G environment (e.g. *Smith:* paragraphs [0039-0040])**; and**

receiving, from the SIP registrar, a notification that indicates that an old contact address based on the combined registration and event subscription message is being replaced by a new contact address for the remote unit. In particular, *Smith* discloses the concept within one of the various embodiments wherein the 2G client subscriber would periodically send a

notification message to update the current location with the Home Location

Register (HLR) (e.g. *Smith:* paragraph [0044]).

In addition, *Das* also further discloses the concept of wherein the mobile

client node can request for an update on the node's address information (e.g.

Das: paragraph [0060]).

Das and *Smith* are analogous art because they are in the same field of

endeavor with respect to registering and subscribing to different networks.

At the time of the invention, it would have been obvious to one of ordinary

skill in the art to combine *Das'* concept of registering and subscribing to networks

within *Smith's* concept of registering and updating a mobile client across various

networks within. The suggestion/motivation for combining them would be to keep

better track of the roaming mobile nodes as they move between various networks

and getting their addresses updated.

As to **claim 2**, *Smith* further discloses **the method of claim 1 wherein**

the combined registration and event subscription message comprises a

SIP REGISTER message and an indication of an event to which the SIP

proxy UA subscribes (e.g. example used in paragraph [0034-0035] discloses of

a husband's mobile client registered and roaming around, which can be tracked

and thus provides indications to the wife of what's going on).

As to **claim 3**, *Smith* further discloses **the method of claim 2 wherein the event to which the SIP proxy UA subscribes is contact address changes** (e.g. paragraphs [0021-0022], example used in paragraph [0034-0035], and Figure 7).

As to **claim 4**, *Smith* further discloses **the method of claim 2 wherein the combined registration and event subscription message comprises a SIP REGISTER message and a SIP SUBSCRIBE message Event header** (registering and subscribing to keep track of new changes, e.g. paragraphs [0039-0040], [0044], and Figures 1 and 7).

As to **claim 5**, *Smith* further discloses **the method of claim 1 wherein the notification further indicates the new contact address for the remote unit** (e.g. paragraphs [0021-0022] and Figure 7).

In addition, *Das* also further discloses the concept of wherein the mobile client node can request for an update on the node's address information (e.g. *Das:* paragraph [0060]).

Das and *Smith* are analogous art because they are in the same field of endeavor with respect to registering and subscribing to different networks.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine *Das'* concept of registering and subscribing to networks within *Smith's* concept of registering and updating a mobile client across various

networks within. The suggestion/motivation for combining them would be to keep

better track of the roaming mobile nodes as they move between various networks

and getting their addresses updated.

As to **claim 6**, *Smith* further discloses **the method of claim 5 wherein**

the notification comprises a SIP NOTIFY message (e.g. paragraph [0044]).

As to **claim 7**, *Smith* further discloses **a method for maintaining SIP**

contact addresses using event subscription:

receiving a combined registration and event subscription message

for a remote unit from a first SIP proxy user agent (UA). In particular, *Smith*

discloses the concept within one of the various embodiments of wherein a 2G

client subscriber in addition to registering with the proxy is also subscribing to

receive information from the 3G environment (e.g. *Smith:* paragraphs [0039-

0040];

storing, as contact information for the remote unit, a first contact

address based on the combined registration and event subscription

message. In particular, *Smith* discloses the concept within one of the various

embodiments of a CellID, which gets updated as the client changes locations

(e.g. *Smith:* paragraph [0044] and Figure 7);

in response to receiving the combined registration and event

subscription message, subscribing the first SIP proxy UA to the contact

information for the remote unit. In particular, *Smith* discloses the concept within one of the various embodiments wherein all the contact information is collected in the HLR (e.g. *Smith:* paragraphs [0045-0046] and Figure 1;

receiving a registration message for the remote unit from a second SIP proxy UA after receiving the combined registration and event subscription message. In particular, *Smith* discloses the concept within one of the various embodiments wherein a mobile client can register with a Visitor Mobile Switching Center (V-MSC), which can also requests for more information from the original HLR (e.g. *Smith:* paragraphs [0028-0029] and Figure 4);

updating the contact information with a second contact address based on the registration message. In particular, *Smith* discloses the concept within one of the various embodiments wherein the contact and location information can be updated as the mobile client roams from place to place and the new information gets updated in the original HLR (e.g. *Smith:* paragraphs [0028-0029[and Figures 1, 4, and 7); **and**

notifying the first SIP proxy UA that the contact information for the remote unit has changed. In particular, *Smith* discloses the concept within one of the various embodiments wherein the 2G client subscriber would periodically send a notification message to update the current location with the Home Location Register (HLR) (e.g. *Smith:* paragraph [0044]).

In addition, *Das* also further discloses the concept of wherein the mobile client node can request for an update on the node's address information (e.g. *Das:* paragraph [0060]).

Das and *Smith* are analogous art because they are in the same field of endeavor with respect to registering and subscribing to different networks.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine *Das'* concept of registering and subscribing to networks within *Smith's* concept of registering and updating a mobile client across various networks within. The suggestion/motivation for combining them would be to keep better track of the roaming mobile nodes as they move between various networks and getting their addresses updated.

As to **claims 8, 9, and 10**, see the similar conceptual rejections of claims 2, 4, and 5 respectively.

As to **claim 11**, *Smith* further discloses **the method of claim 10 wherein notifying comprises notifying the first SIP proxy UA that the second contact address has replaced the first contact address** (the mobile client would periodically update the location and contact information with each new proxy as it moves around and back with the HLR, e.g. *Smith:* paragraph [0044] and Figure 7).

In addition, *Das* also further discloses the concept of wherein the mobile client node can request for an update on the node's address information (e.g. *Das:* paragraph [0060]).

Das and *Smith* are analogous art because they are in the same field of endeavor with respect to registering and subscribing to different networks.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine *Das'* concept of registering and subscribing to networks within *Smith's* concept of registering and updating a mobile client across various networks within. The suggestion/motivation for combining them would be to keep better track of the roaming mobile nodes as they move between various networks and getting their addresses updated.

As to **claim 12**, see the similar conceptual rejection of claim 6.

As to **claim 13**, see the similar conceptual rejection of claim 4.

As to **claim 14**, see the similar corresponding conceptual rejection of claim 1. In addition, *Smith* further discloses the concepts of

a wireless network interface (wireless telecommunication networks with various interfaces, e.g. *Smith:* paragraphs [0039])**; and**

a SIP proxy user agent, communicatively coupled to the wireless

network interface, adapted to (e.g. *Smith:* paragraph [0039])…(see the

conceptual rejections of claim 1).

As to **claim 15**, see the similar conceptual rejection of claim 7. In addition,

Smith further discloses the concepts of

a SIP location data base (SIP User Agent Server (or database), e.g.

Smith: paragraph [0039])**; and**

a SIP registration processor, communicatively coupled to the SIP

registration data base, adapted to (processor exists within a database, e.g.

Smith: paragraph [0039])…(see the corresponding conceptual rejection of claim

7).

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to XIANG YU whose telephone number is (571)270-5695.

The examiner can normally be reached on Monday - Friday 8:00am - 5:00pm with every

other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Patrice L. Winder can be reached on (571)272-3935. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrice Winder/
Primary Examiner, Art Unit 2445

/X. Y./
Examiner, Art Unit 2445